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09/903,022

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Yuri Shtivelman

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/903,022	<b>Applicant(s)</b> SHTIVELMAN ET AL.	
	<b>Examiner</b> Steven HD Nguyen	<b>Art Unit</b> 2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18, 20, 22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 22, 24-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 18, 20, 22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen (USP 7254219) in view of Taylor (WO 00/18094) and Norris (USP 5805587).

Hansen discloses a call waiting system which comprises ISP, SCP and user's computer includes the cooperating software on the user's Internet appliance presents each incoming call as an icon wherein the user manipulates the individual icons for performing call forward, voice mail, answer (Fig 3-10 discloses online call alert with the icons for performing the transferring function). However, Hansen fails to disclose when a user operating the Internet appliance connects to the ISP for Internet connection services a call forwarding service is automatically initiated causing the ISP to instruct the SCP to forward calls for the user to a specific number associated with the ISP, the specific number being to a switch that converts incoming calls to TCP/IP format and connects them to the user's Internet appliance. In the same field of endeavor, Taylor discloses a call-waiting system comprising a service control point (SCP) (Fig 1, Ref 112) in a public switched telephony network (PSTN) (Fig 1, Ref 170); an Internet-connected service provider (ISP) (Fig 1, Ref 120); and cooperating software executing at the ISP, SCP and on a user's Internet appliance for providing a call-waiting service (Fig 1, Ref 102, 112 and 120 include a executing software); wherein, when a user operating the Internet appliance connects to

the ISP for Internet connection services a call forwarding service is automatically initiated causing the ISP to instruct the SCP to forward calls for the user to a specific number associated with the ISP (Page 12, lines 6-20), the specific number being to a switch of ISP that converts incoming calls to TCP/IP format and connects them to the user's Internet appliance (Fig 7, ISP for conveying voice between caller and called using IP and PSTN protocol). However, Taylor and Hansen fail to disclose a switch that converts incoming calls to TCP/IP format and connects them to the user's Internet appliance. In the same field of endeavor, Norris discloses that converts incoming calls to TCP/IP format and connects them to the user's Internet appliance (Fig 3, Ref 235 and 245).

Since, Hansen discloses Norris in the background of his invention and the use of SCP and ISP for performing the call forwarding. Therefore, it would have been obvious to one ordinary skill in the art to apply a switch with a function to converts incoming calls to TCP/IP format and connects them to the user's Internet appliance as disclosed by Norris into Taylor which discloses a software for allowing incoming call to be routed to ISP into the teaching of Hansen. The motivation would have been to reduce human error and provide user friendly GUI.

3. Claims 18, 20, 22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen (USP 7254219) in view of Tonnby and Barker and Norris (USP 5805587).

Hansen discloses a call waiting system which comprises ISP, SCP and user's computer includes the cooperating software on the user's Internet appliance presents each incoming call as an icon wherein the user manipulates the individual icons for performing call forward, voice mail, answer (Fig 3-10 discloses online call alert with the icons for performing the transferring function). However, Hansen fails to disclose when a user operating the Internet appliance

connects to the ISP for Internet connection services a call forwarding service is automatically initiated causing the ISP to instruct the SCP to forward calls for the user to a specific number associated with the ISP, the specific number being to a switch that converts incoming calls to TCP/IP format and connects them to the user's Internet appliance. In the same field of endeavor, Baker discloses a method and system for notifying an incoming call from ISP to the internet user by using icon and when a user operating the internet appliance connect to the ISP for internet connection services a call forwarding service is automatically initiated causing the ISP to instruct the SCP to forward calls for the user to a specific number associated with ISP (Page 34, lines 4 to page 35, lines 20 and Page 45, lines 16-27, after the user connected to ISP, the ISP instructs the telephone company central office to forward to call to the telephone number of ISP wherein the ISP will notify the incoming call to the internet user by present an icon wherein ISP and user's device has a software for notifying and accepting a call and PSTN has a software for forwarding the call to ISP). However, Barker and Hansen fail to disclose a switch that converts incoming calls to TCP/IP format and connects them to the user's Internet appliance. In the same field of endeavor, Norris discloses that converts incoming calls to TCP/IP format and connects them to the user's Internet appliance (Fig 3, Ref 235 and 245). However, Hansen, Norris, Barker fail to disclose outgoing calls with call waiting. In the same field of endeavor, Tonnby discloses outgoing calls with call waiting Figs 1-4 and 6 have a loaded software for executing the functions based on incoming from network or outgoing calls from a user).

Since, Hansen discloses Norris in the background of his invention and the use of SCP and ISP for performing the call forwarding. Therefore, it would have been obvious to one ordinary skill in the art to apply a switch with a function to converts incoming calls to TCP/IP format and

connects them to the user's Internet appliance as disclosed by Norris into Barker which discloses a software for allowing incoming call to be routed to ISP into the teaching of Tonnby which discloses a method and system for initiating outgoing calls into the teaching of Hansen. The motivation would have been to reduce human error and provide user friendly GUI.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/01/2008 have been fully considered but they are not persuasive.

In response to pages 8-10, the applicant states that Hansen does not disclose an SCP in the PSTN. In reply, Hansen discloses SCP in the PSTN as show in Referring now to FIG. 12, there is shown a more specific flow diagram of the subscriber taking a phone communication over the public switched network in one embodiment of the present invention. For example, an incoming phone communication 101 is made from calling station 24 while the subscriber is currently on an Internet session. A termination attempt trigger is encountered in the subscribers serving office (service switching point SSP) and call processing is halted. An AIN termination attempt query is sent to the AIN database (SCP pair) via the SS7 network, routed through both the local and regional STP pairs as shown in step 102. In step 103, the AIN database analyzes the incoming query and sends a get data query or subscriber status query to the application server 22 to determine if the subscriber is on an Internet session. In response, as shown in step 104, the application server sends a response or subscriber status response to the get data query with an indication that the subscriber is on an Internet session. The AIN database sends a get data query to the LIDB SCP for CNAM as noted in step 105. The LIDB SCP sends a get data response with

the CNAM information in step 106. In step 107, the AIN database then sends a get data query or present options query to the application server 22 instructing the gateway device to prompt the subscriber with a the application server sends a screen viewable message 36 to the subscriber via the Internet which includes available calling station identification information 38 and a query 40 to the subscriber on the disposition of the call from a list of disposition options as described above. In step 108, the application server 22 sends message through the Internet service provider via the Internet access server 16 and the associated IP connection to the subscriber providing the screen viewable message 36. The subscriber, in this embodiment chooses to take the call over the public switched network PSTN 18 and "clicks" the appropriate option as noted in FIG. 3 as an option. The application server responds back to the AIN database that the call is to be routed over the PSTN 18 as noted in step 109. Initiated simultaneously or very short after step 107, the AIN database sends a send to resource message to the SSP across the SS7 network instructing the switch SSP to bridge a connection with the Intelligent Services Peripheral for an announcement as noted in step 110. In step 111, the SSP establishes a connection with the ISP via a PRI connection from the SSP to the ISP for the announcement play-back. The ISP plays the announcement stating for example "please hold as we try to connect your party" as shown in step 112. In step 113, the SSP sends a resource clear message to the AIN database across the SS& network to let the AIN database know that the announcement is complete. The AIN database sends a response message back to the SSP to terminate the call to the subscriber. The SSP receives the message and forwards the call to the subscriber as noted in step 114. Finally, in step 115, the call is routed to the subscriber's line. Furthermore, the applicant states that Taylor does not disclose SCP which performs the claimed invention because the function of

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the claimed invention performs at AP. In reply, Ap discloses software for performing the claimed invention. Therefore, it would have been obvious to one of ordinary skill in the art to implement this software into SCP as stated in the final office action above. The combination of the prior arts discloses the claimed invention.

5. In response to pages 10-11, the applicant stated that the combination of Hansen, Tonnby, Barker and Norris is improper. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of the prior arts disclosed the claimed invention. Hansen suggests the use of SCP, ISP and Norris in the background. Therefore, it would have been obvious to one of ordinary skill in the art to implement the teaching of Barker, Tonnby, Norris or Taylor into the



teaching of Hansen with a motivation showed above because a software can be installed on the device such as SCP etc...

7. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

8. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571)272-3159. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jayanti Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven HD Nguyen/  
Primary Examiner, Art Unit 2419.